REMARKS

The present application was filed on March 26, 2001 with claims 1-25. In the outstanding Office Action, the Examiner: (i) rejected claims 1-5, 12-16, 21 and 25 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,852,803 to Ashby, III et al. (hereinafter "Ashby"); and (ii) rejected claims 6-11, 17-20 and 22-24 under 35 U.S.C. §103(a) as being unpatentable over Ashby in view of U.S. Patent No. 6,173,250 to Jong (hereinafter "Jong").

Regarding the §102 rejection based on Ashby, Applicants have amended independent claims 1, 12, 21 and 25 to further clarify the subject matter of the invention. Claims 6, 17 and 22 have been canceled. Various dependent claims have also been amended in order to maintain consistency with the amended independent claims.

More specifically, Applicants have added limitations of canceled claim 6 to independent claims 1 and 25, added limitations of canceled claim 17 to independent claim 12, and added limitations of canceled claim 22 to independent claim 21. Since the Office Action acknowledges that Ashby fails to disclose the limitations of canceled claims 6, 17 and 22, Applicants request withdrawal of the §102 rejection.

Regarding the §103 rejection of the claims based on the combination of Ashby and Jong, Applicants respectfully traverse such rejection for at least the following reasons.

First, there is a clear lack of motivation to combine the references. Ashby is directed to problems associated with recording and retrieving audio information associated with a product label, while Jong is directed to problems associated with transmitting data over the Internet. That is, the teachings in each reference are directed to completely different environments; one (Ashby) toward product labeling, the other (Jong) toward Internet communication. However, other than a very general and conclusory statement in the Office Action, there is nothing in the two references that reasonably suggests why one would actually combine the teachings of these two references.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory

statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344.

In the Office Action at page 7, the Examiner provides the following statement to prove motivation to combine Ashby and Jong, with emphasis supplied: "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Ashby . . . to obtain text information by converting the user spoken utterances input, as taught by Jong, in order to produce text for deaf or hearing-impaired.

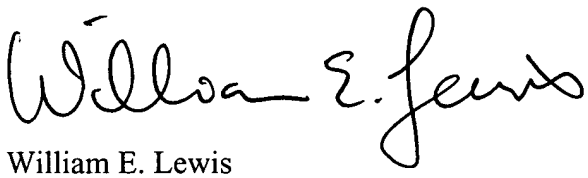
Applicants submit that this statement is based on the type of "subjective belief and unknown authority" that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

That is, despite the stated motivation of the Examiner (i.e., in order to produce text for deaf or hearing-impaired), there appears to be absolutely no disclosure in Ashby or Jong regarding the deaf or hearing-impaired. In fact, Applicants submit that Ashby teaches away from a combination with Jong since, at column 3, lines 15 and 16, Ashby states that "the output signal is not internally synthesized." This clearly implies that Ashby does not contemplate converting the speech to text and then synthesizing output speech from the text.

Second, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Ashby and Jong. Despite the assertion in the Office Action, Applicants do not believe that Ashby and Jong are combinable since it is not clear how one would combine them. There is no guidance provided in the Office Action.

In view of the above, Applicants believe that claims 1-5, 7-16, 18-21 and 23-25 are in condition for allowance, and respectfully request withdrawal of the §102 and §103 rejections.

Respectfully submitted,



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